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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,451	10/09/2001	Myron K. Jacobson	NIAD-201.3 DIV - AP/NDH	7369
7590	10/25/2004		EXAMINER	
Fulbright & Jaworski LLP 666 Fifth Avenue New York, NY 10103			FETTEROLF, BRANDON J	
			ART UNIT	PAPER NUMBER
			1642	

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/973,451	JACOBSON ET AL.	
	Examiner	Art Unit	
	Brandon J Fetterolf, PhD	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/02/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Jacobson *et al.*

Date of Priority: 5/01/1998

DETAILED ACTION

Response to Amendment

The Amendment filed on 09/02/2004 in response to the Office Action filed on June 4, 2004 is acknowledged and has been entered.

Claims 69-80 are currently pending and under consideration

Response to Declaration

The Declaration filed on 09/02/2004 in response to the Office Action filed on June 4, 2004 has been considered and is objected to for the following informalities:

On page 2 of the Declaration, the applicant states "Nasreen Aboul-Ela is listed as a co-author of the paper referred to in "2", but was not a con-inventor". The term "con-inventor" is confusing and unclear.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Rejections Maintained:

Claims 67-80 **remain** rejected under 35 USC 103(a) as being unpatentable over Lin et al. in further view of Cambell, A..M. for the reasons of record in the Action mailed 06/04/2004 (pages 3-4).

Applicants have argued (Remarks, 09/02/2004) that the pending claims claim a priority date of May 1, 1998 and that Lin et al. was published less than one year prior to the priority date of May 2, 1997. Applicants further provide a declaration in accordance with *In re* Katz, 215 USPQ 14 (CCPA 1982) establishing that Nasreen Aboul-Ela was not and is not a co inventor in 1997, nor in

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2000. Furthermore, Applicants argue that since Nasreen Aboul-Ela is not a co-inventor it would not have been obvious to one of ordinary skill in the art at the time the invention was made to use the encoded PARG for the purpose of generating antibodies that specifically bind to the claimed peptides, because the protein was not described "by others". This argument has been considered but is not found persuasive, as the declaration is deemed defective for the reasons set forth above.

Thus, for the reasons of record and for the reasons set forth above, applicant's arguments have not been found persuasive and the rejection is maintained.

New Objections

The Specification is objected to for the following reasons: The Specification on page 1, line 3 should be amended to reflect the priority status of the present application, for example:

It is also a divisional of application Serial No. 09/302, 812, filed on April 30, 1999, now U.S. Patent No. 6,333,148.

Claim 71 is objected to because the claim appears to be missing a word after "hybridizes".

New Rejections

Claims 67-80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. THIS IS A NEW MATTER REJECTION.

Claims 67-80 refers to an isolated antibody which binds specifically to a protein which catalyzes the release of ADP-ribose from an ADP ribose polymer. In the amendment filed on April 12/03/2003, the applicant cancelled claims 1-66 and added new claims 67-80. The specification and claims as originally filed does not lend support for the limitation of an isolated antibody that binds to a protein which catalyzes the release of ADP-ribose from an ADP ribose polymer.

Although, the Applicant on page 4 of the Amendment believes that "Claims 67 et seq. Parallel claims allowed in U.S. Patent No. 6,337,2002", this statement does not appear to provide evidence that this functional limitation of the protein as claimed is present in the instant application Serial Number 09/973451 nor in its parent application 09/302, 812, now U.S. Patent No. 6,333,148.

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Applicant is invited to point to clear support or specific examples of the claimed limitation in the specification as-filed or remove such amendatory language in response to this office action.

No claim is allowed.

All other rejections and or objections are withdrawn in view of applicant's amendments and arguments there to.

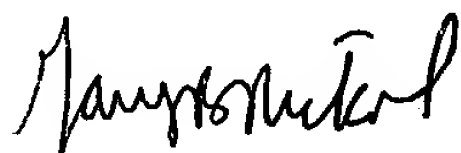
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J Fetterolf, PhD whose telephone number is (571)-272-2919. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brandon J Fetterolf, PhD
Examiner
Art Unit 1642

BF



**GARY NICKOL
PRIMARY EXAMINER**